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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,318	04/03/2001	Adolf Stender	64251-022	2510

7590

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EXAMINER

RIBAR, TRAVIS B

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

45-13

Office Action Summary

Application No.

09/825,318

Applicant(s)

STENDER ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims 22-30 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 11-13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgdorfer et al. ('838) in view of Steppan et al. and Abe.

The office action dated October 21, 2002 contains the text of this rejection. The original rejection included claim 9, the limitations of which have been included by amendment into the present form of claim 1.

4. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgdorfer et al. ('838) in view of Steppan et al.

The office action dated March 18, 2002 contains the text of this rejection. Regarding the newly added limitation of claim 1— where the polyurethane (PU) gel is an undercured reaction product of polyols and polyisocyanates, support for this is found in claim 1 of Burgdorfer et al. ('838).

5. Claims 14-15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgdorfer et al. ('642) in view of Steppan et al. and Abe.

Burgdorfer et al. ('642) is the English language equivalent of Burgdorfer et al. ('838) and discloses PU adhesive gels made from a reaction between polyols and polyisocyanates. The polyisocyanates (column 7, line 34 to column 8, line 19) are the same as those the applicant claims in claims 17-21 and the polyol components (column 2, lines 36-40) have the same molecular weight and OH number the applicant claims in claims 14 and 15. Burgdorfer et al. ('642) also includes the isocyanate index of claim 15 (column 3, line 31), product of the isocyanate functionality and the functionality of the polyol in claims 14 and 15 (column 3, lines 55-58), and the combination of polyols in claim 14 (see example 1 in the reference).

The gel in Burgdorfer et al. ('642) is not explicitly disclosed as being undercured. However, example 7 (column 16) indicates that the gellation reaction takes place for one minute. This is considerably less time than the amount of time that Burgdorfer et al. ('642) indicates is needed to fully cure a gel (column 13, lines 48-51). The examiner therefore believes that Burgdorfer et al. ('642) discloses an undercured PU gel meeting that limitation of claim 1.

The gel in Burgdorfer et al. ('642) also includes fillers (column 10, lines 46-48), but does not specifically state that the fillers are elastic microspheres. That aspect of the invention is found in Steppan et al. and Abe. Elastic microsphere fillers in PU compositions are well known in the art and are seen in Steppan et al. (column 10, lines

16-49) and Abe (column 4, lines 21-46). The elastic microspheres are useful for decreasing the density of the PU compositions and for allowing air to escape from an adhesive-substrates interface during application.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use elastic microspheres such as those in either Steppan et al. or Abe in the adhesive composition in Burgdorfer et al. ('642). The motivation for doing so would be to decrease the density of the adhesive and to allow air to escape the interface between the adhesive and the substrate during application. Therefore it would have been obvious to combine Steppan et al. or Abe with Burgdorfer et al. ('642) to obtain the invention as specified in claims 14-15 and 17-21.

Response to Arguments

6. The examiner notes that the applicant did not address the examiner's application of Burgdorfer et al. ('838) to the present application.

7. The applicant argues the applicability Steppan et al. and Abe because they do not feel that the microspheres in Steppan et al. are filler or that they are elastic, and because they do not feel that that Abe discloses that the microspheres are filler. Regarding Steppan et al., the examiner notes that the microspheres used in Steppan et al. are the same microspheres the applicant cites as useful in their invention (e.g. page 7, line 28 of the specification). In addition, Steppan et al. states that the microspheres

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are elastic and since they are non-reactive parts of the composition in the reference, they constitute filler.

Similarly in Abe, the elastic microspheres are used as non-reactive materials, thereby constituting filler. In addition, the examiner believes that the figures the applicant cites as showing that the microspheres are not filler do show that the microspheres are, in fact, filler (figures 1A and 1B of the reference).

8. Applicant's arguments with respect to other aspects of claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711

TBR
April 3, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700